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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

50699/11

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Application Number

10/625,102

Filed

July 22, 2003

First Named Inventor

Pedro M. Buarque de Macedo

Art Unit

3637

Examiner

Michael Safavi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record. 32,781
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Charles R. Macedo

Typed or printed name

212-336-8000

Telephone number

November 28, 2007

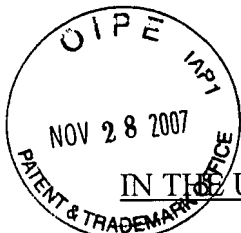
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/625,102

Confirmation No.: 8891

Applicant : Pedro M. Buarque de Macedo

Filed : July 22, 2003

TC/A.U. : 3637

Examiner : Michael Safavi

Docket No. : 50699/11

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, a request for a review of the final rejection of the pending claims in the above-identified application is hereby submitted. This pre-appeal brief request is filed specifically in response to legal and factual deficiencies in the final Office Action mailed August 24, 2007. Nonetheless, all rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved. This Request is being filed with a Notice of Appeal.

The review is requested for at least the following reasons:

I. A *Prima Facie* Case of Obviousness for the Pending Claims Over Prior Art Has Not Been and Cannot Be Established

The claimed subject matters of the present application require, *inter alia*, a prestressed foam glass tile with a very high prestress compression/compression strength. The specification of the present application discloses how such strong prestressed foam glass tiles can be achieved and used as a very strong building material. *See, e.g.*, Specification (as originally filed), Table 1 and Pars. [0049]-[0053].

In the prior office actions, the Examiner had maintained the position that combinations of no less than nine prior art references render the claimed subject matters obvious. *See, e.g.*, Office Action mailed September 11, 2006, at 8; Office Actions mailed March 3, 2006, at 8.

Significantly, there is no dispute that none of the nine references anticipates the claimed invention.

In response, Applicant provided extensive rebuttal arguments that (1) none of the prior art teaches or suggests the prestressing of a foam glass tile, let alone the claimed range of prestress compression (*see, e.g.*, Reply to September 11, 2006 Final Office Action at 10-17); (2) there is no reason or legitimate rationale or proper motivation to combine the prior art to obtain the claimed ranges of compression strength and prestress compression (*see, e.g., id.* at 23-27), or the claimed ranges of pore size and prestress compression (*see, e.g., id.* at 36-39); (3) the prior art taught away from the claimed range of prestress compression (*see, e.g., id.* at 27-32); (4) none of the prior art shows a reasonable expectation of success for obtaining the claimed range of prestress compression (*see, e.g., id.* at 17-18); (5) none of the prior art enables the claimed range of prestress compression (*see, e.g., id.* at 18-20) or of compression strength (*see, e.g., id.* at 32-35); and (6) none of the prior art teaches or suggests the claimed range of compression strength (*see, e.g., id.* at 20-23).

Furthermore, to support these arguments, Applicant submitted on May 2, 2007 a Declaration Under 37 C.F.R. § 1.132 by the inventor, Dr. Pedro M. Buarque de Macedo, (“the Inventor’s Declaration”). The Inventor’s Declaration demonstrated that the extensive combinations of prior art references that the Examiner relied on would not have made any sense to a person of ordinary skill in the art, nor would they have led such person to the claimed invention. *See* Declaration Under 37 C.F.R. § 1.132 (dated May 1, 2007), Pars. 5-27. It is respectfully submitted that in view of the foregoing rebuttal evidence and arguments presented by Applicant, a *prima facie* case of obviousness for the pending claims over the prior art has not been and cannot be established.

In the August 24, 2007 Office Action, the Examiner reiterated his previous grounds based on the combinations of the same nine prior art references for final rejection, but failed to address, let alone rebut, each and every rebuttal evidence and argument presented by Applicant mentioned above. Accordingly, it is respectfully requested that the rebuttal evidence and arguments presented by Applicant be reviewed and the final rejection of the pending claims be withdrawn in view thereof.

II. Meaningful Consideration Was Not Given to the Inventor's Declaration When Re-evaluating Obviousness Determination

In the August 24, 2007 Office Action, the Examiner summarily dismissed the Inventor's Declaration, without addressing the substance therein, by taking a position that "the declaration of Pedro M. Buarque De Macedo appears to present nothing more than matter of opinion." Aug. 24, 2007 Office Action at 13. The August 24, 2007 Office Action provides no indication that the Examiner gave meaningful consideration to the Inventor's Declaration when re-evaluating his obviousness determination, nor does it provide any substantive explanations for supporting the Examiner's dismissal of the Inventor's Declaration.

As an initial matter, the Inventor's Declaration did not merely present a "matter of opinion." Instead, it provided further detailed analysis of the cited prior art and explained how the Examiner's rejection was based on a faulty understanding of the prior art disclosures. It further presented evidence of the unexpected benefits of the claimed invention, including the test results. *See* Declaration Under 37 C.F.R. § 1.132 (dated May 1, 2007), Par. 26 and FIGS. 1-3. However, the Examiner did not address any of this evidence in the August 24, 2007 Office Action.

When an applicant puts forth relevant rebuttal evidence, including the inventor's declaration, the Examiner **must** consider such evidence. *See In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007) (holding that the Board of Patent Appeals committed error by failing to consider the rebuttal evidence submitted by the applicant, which includes the inventors' declarations); *see also* MPEP 716.01 ("Evidence traversing rejections, when timely presented, **must be** considered by the examiner whenever present. . . . Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements . . . without an explanation supporting such findings are insufficient." (emphasis added)); Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*, 72 Fed. Reg. 57,526, 57,534 (Oct. 10, 2007) ("the *KSR* Guidelines") ("Office personnel should consider all rebuttal evidence that is timely presented by the applicants when reevaluating any obviousness determination.").

"Evidence rebutting a prima facie case of obviousness can include . . . evidence that the prior art teaches away from the claimed invention in any material respect." *In re Sullivan*, 498

F.3d at 1351 (citation and internal quotation marks omitted); *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 82 U.S.P.Q.2d 1385, 1395 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”). The Inventor’s Declaration submitted in the present application discusses, *inter alia*, why those skilled in the art would not have applied the range of prestress compression claimed by the present application in view of the range of compression strength of a foam glass product disclosed by the prior art relied upon by the Examiner. *See* Declaration Under 37 C.F.R. § 1.132 (dated May 1, 2007), Pars. 20-21. Therefore, the Inventor’s Declaration is relevant as evidence that the prior art taught away from the claimed invention. *See, e.g.*, Reply to September 11, 2006 Final Office Action (dated May 2, 2007), at 29 to 32.

By failing to give the timely submitted rebuttal evidence in the Inventor’s Declaration meaningful consideration before arriving at his conclusion, the Examiner thus committed a clear error. Had the Examiner considered or reviewed the Inventor’s Declaration in any meaningful way, he should have arrived at a different conclusion than he did. *See In re Sullivan*, 498 F.3d at 1353. Hence, it is respectfully requested that the final rejection of the pending claims in the August 24, 2007 Office Action be withdrawn and the pending claims be reconsidered and allowed in light of the Inventor’s Declaration.

III. The Required Finding that the Results of the Prior Art Combinations Were Predictable Was Not Made

To support obviousness rejections based on prior art combination, the U.S. Patent Office asks the Examiner to articulate, among others, “a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.” The *KSR* Guidelines, 72 Fed. Reg. at 57,529 (emphasis added); *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 82 U.S.P.Q.2d 1385, 1395-96 (2007) (“[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” (emphasis added)). However, the Examiner never made the required finding in the August 24, 2007 Office Action to support his final rejection of the pending claims, despite his reliance on such extensive combinations of references. In fact, such finding that one of ordinary skill in the art would have recognized that the results of the combinations were predictable could not have been made in this case, since the Inventor’s Declaration demonstrated that the prior art relied upon by the Examiner taught away from the claimed invention. *See* Declaration Under 37

C.F.R. § 1.132 (dated May 1, 2007), Pars. 20-21; Reply to September 11, 2006 Final Office Action (dated May 2, 2007), at pages 29 to 32, 44 to 45, 51-52.

Based on the Examiner's failure to make the foregoing finding and further in view of the rebuttal evidence in the Inventor's Declaration, which the Examiner failed to give meaningful consideration as discussed above, it is respectfully submitted that the Examiner did not and cannot establish the *prima facie* case of obviousness based on the prior art combinations set forth in the August 24, 2007 Office Action. At least on this basis alone, the Examiner's final rejection of the pending claims should be withdrawn, and such withdrawal is respectfully requested.

* * *

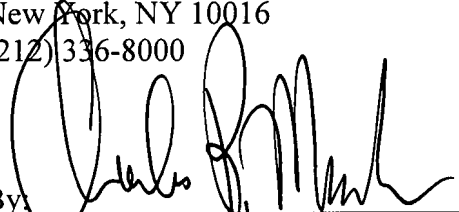
At least for the foregoing reasons, the final rejection of record is clearly improper and should be withdrawn. Applicant respectfully requests review of the final rejection in the above-identified application.

No fee is deemed necessary in connection with the filing of this Request. However, if any fee is required, authorization is given hereby to charge any such fee to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Applicant
90 Park Avenue
New York, NY 10016
(212) 336-8000

Dated: New York, New York
November 28, 2007

By: 
Charles R. Macedo
Registration No.: 32,781